

Serial No. 09/872,500
Filed: 06/01/01
Page 2 of 8

Examiner: Thomas Price
Group Art Unit: 3643

REMARKS

In the Office Action, the Examiner deemed the election requirement to be proper in view of the fact that Applicants did not state on the record that these species are obvious variants. Applicants do not believe that the alleged species set forth by the Examiner are in fact obvious variants of each other. In fact, Applicants believe that the various alleged species set forth by the Examiner are not proper species for election. Furthermore, Applicants know of no requirement why they must state on the record that the claimed species are obvious variants of one another in order to defeat a restriction requirement. There is no requirement in the statute or the rules that Applicants make such a statement. The Examiner is in error in his election requirement.

CLAIM REJECTIONS - 35 U.S.C. § 112

Claims 45, 46, 56, 58, 59, and 61-63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite or failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

The Examiner has raised questions as to the terms "tough" and "effective" in the independent claims 45 and 56. The word "tough" in the independent claims 45 and 56 is used in conjunction with the terms "chew resistant material" and must be read in the context of these terms as well as the preamble that refers to an article that is to be played with, enticed, or retrieved by domestic animals. Thus, the phrase "tough, chew resistant material" means that the material is strong enough to resist destruction by a domestic animal for which is designed. The particular material may vary depending on the nature of the market for the article. In common ordinary terms, the phrase "tough chew resistant material" has the ordinary meaning as commonly understood by those in the domestic animal toy art, i.e., requiring relatively high amounts of energy to break the material by domestic animals for which the articles are intended.

The term "effective" is a term of art used in patent claims in the pharmaceutical and herbicidal art to mean that amount of the particular claimed compound that imparts the stated property or benefit to the article or to a patient. The term "effective" in these claims denotes a

Serial No. 09/872,500
Filed: 06/01/01
Page 3 of 8

Examiner: Thomas Price
Group Art Unit: 3643

sufficient amount of microbe-cidal agent being applied that microbes are killed or otherwise rendered ineffective. To say it another way, the term "effective" is a term of art that means that the amount of microbe-cidal agent is sufficient to render the article inhospitable to microbes. See Applicants' specification, page 7, lines 24-27. Further, as indicated throughout the text of the specification, different amounts of the various microbe-cidal agents are required to provide such "effective" amounts, depending on the type of microbe-cidal agent, the textile casing material, environmental conditions and the target market for the article. A full discussion of the factors that influence the amount of microbe-cidal agent that is incorporated into any textile fabric is set forth throughout the specification, including page 3 lines 10-28; page 4, lines 8-16; page 7, line 24 through page 8, line 12. It is believed that this discussion of the amounts of microbe-cidal agents that are used in various environments with the articles claimed in this application give one that has ordinary skill in the art of domestic animal toys sufficient information to make and use the claimed invention.

In view of the foregoing, it is submitted that the claims are not indefinite under 35 U.S.C. § 112.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 45, 46, 56, and 50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimm, U.K. Patent Application No. 2182857 (Grimm et al. '857) in view of Bersted et al. U.S. Patent No. 5,945,215 (Bersted et al. '215). This rejection is respectfully traversed.

The Grimm et al. '857 patent is directed to cuddly toys for children. The toys have a pile that can be groomed and in which at least one symbolic or pictorial mark is applied to the pile such that the mark is discernible when the pile is groomed and indiscernible when the pile is not in the groomed condition. The fabric does not appear to be to chew resistant or tough. No mention is made anywhere in this reference of a problem with microbes.

The Bersted et al. '215 patent is directed to polypropylene fibers and yarns characterized by a unique crystalline microstructure which exhibit improved recovery from compression and

Serial No. 09/872,500
Filed: 06/01/01
Page 4 of 8

Examiner: Thomas Price
Group Art Unit: 3643

bending. The only place in the patent where the word "anti-microbial" is mentioned is the passing list at column 17, lines 1-6 of potential additives to the polypropylene fibers of the invention:

The inventive fibers also can comprise of various additives and modifiers. A wide variety of such materials is well known to the art; examples include pigments, finishes and other process aids, flame retardant, heat and light stabilizers, anti-microbial agents, electrically conductive materials, anti-static agents and stain resisting agents. . . .

None of the examples of Bersted et al. '215 include anti-microbial agents in the formulations and there is no mention of any specific and anti-microbial agents. Further, there is no teaching of the application of an effective amount of an anti-microbial agent for any particular use. Once again, the patent is directed to polypropylene fibers with improved recovery from compression and bending.

The combination of Grimm et al. '857 and Bersted et al. '215 is traversed. There is no basis for the alleged combination of references and the Examiner has given none.

There is no reason for one of ordinary skill in the art to combine Grimm et al. '857 with Bersted et al. '215. Grimm et al. '857 does not suggest or recognize a problem of microbial contamination with their children's toys, and hence there is no reason to look for a reference which teaches the incorporation of anti-microbial agents in fibers of the type used in their toys. Grimm et al. '857 is directed to children's toys, for which there is not a generally recognized problem with microbial contamination or with chew-resistant articles. Such toys have a very different pattern of use than amusement articles for pets which are routinely salivated on, have partially digested food deposited upon, urinated upon, and otherwise soiled and hence have a very real problem of microbial contamination.

Further, Bersted et al. '215 do not provide any real teaching of anti-microbial agents, but merely include the mention of such agents and a laundry list of potential additives to the fibers.

Examiner represents that it would be obvious to a person of ordinary skill in the art at the time of invention is made to modify the "apparatus" of Grimm et al. '857 with a microprobe-cidal agent in view of the teaching of Bersted et al. '215, in order to reduce the occurrence of bacteria

Serial No. 09/872,500
Filed: 06/01/01
Page 5 of 8

Examiner: Thomas Price
Group Art Unit: 3643

on the article. However, both references are silent as to the need to reduce the occurrence of bacteria on the article. Neither of the references recognizes the need set forth above and disclosed in the background for Applicants invention. There is no disclosure in either of the references of the problem to be solved. Thus, there would be no motivation for solving an unknown or unrecognized problem by combining the two drastically unrelated references. The standard for combining references in a patentability analysis under 35 U.S.C. § 103(a) is set forth recently in the case *In re Sang-Su Lee* 277 F.3d 1338; 61 USPQ2d (BNA) 1430 at pages 1342-1344 as follows:

As applied to the determination of patentability vel non when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." *In re Graselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deer Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp., v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)

Serial No. 09/872,500
Filed: 06/01/01
Page 6 of 8

Examiner: Thomas Price
Group Art Unit: 3643

(""teachings of references can be combined only if there is some suggestion or incentive to do so."") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of the ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In view of the foregoing, it would not have been obvious to combine the at best incidental teaching of the Bersted et al. '215 reference with the Grimm '857 disclosure. The Examiner has given no explanation of how the teaching of Bersted is suggested for use in the Grimm '857 teddy bear. Nor has the Examiner explained how the disclosure in the Bersted et al. '215 patent could be used in the fleece article of the Grimm '857 patent. Thus, the alleged combination of the Bersted et al. '215 reference with the Grimm '857 reference is inappropriate to meet claims 45, 46, and 56-65.

However, even if the alleged combination of Bersted et al. '215 and Grimm '857 were made, however untenably, it still would not reach Applicants' claimed invention. At best, the alleged combination would incorporate into the Grimm et al. fleece some fibers which have been some anti-microbial agents (of undefined nature and of undefined concentrations). It is not clear whether the polypropylene fibers of Bersted et al. '215 would be incorporated into the fleece or would be otherwise incorporated into other portions of the teddy bear or to what extent the fibers would be incorporated into either. There is a clear lack of enabling disclosure to make the

Serial No. 09/872,500
Filed: 06/01/01
Page 7 of 8

Examiner: Thomas Price
Group Art Unit: 3643

alleged combination. Contrast the stark disclosure in Bersted et al. '215 with the extensive enabling disclosure in Applicants' written description of the invention.

All of the rejected claims distinguish over the alleged combination of Grimm '857 and Bersted et al. '215 in calling for an outer textile casing formed of a tough, chew resistant material.

The alleged combination has no disclosure of a tough, chew resistant material that is suitable to be played with, enticed to retrieve by a domestic animals. Since the alleged combination would be a fabric as disclosed in the Grimm '857 reference, it would likely be a soft material which would easily be destroyed by a domestic animal such as a dog.

The rejected claims further define over the alleged combination of Grimm' '857 in view of Bersted et al. '215 in calling for an effective amount of a microbe-cidal agent applied to the textile casing. The alleged combination has no enabling disclosure of an "effective amount" of an anti-microbial compound. Still further, the alleged combination would not have an effective amount of a microbe-cidal agent as required by the rejected claims. Still further, the alleged combination of the Grimm '857 and Bersted et al. '215 would not have the amount of a microbe-cidal agent to be non-toxic and non-carcinogenic when ingested by domestic animals at the levels used in the amusement article. This feature is not found in the alleged combination of Bersted et al. '215 and Grimm '857.

Claim 58 depends from claim 56 and calls for the microbe-cidal agent to be 2, 4, 4'-trichloro-2'-hydroxydiphenyl. This compound is not disclosed in the Examiner's alleged combination of references. The Examiner's bald statement that "the microbe-cidal agent is well-known and thus deemed to be obvious to one of ordinary skill in the art at the time of the invention was made" is unsupported by the alleged combination of references or any other reference cited by the Examiner.

It is noted with appreciation that claim 61-63 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 (second paragraph) and to include all of the limitations of the base claim and any intervening claims. In view of Applicants' position as to the rejection under 35 U.S.C. § 112 as set forth above and with respect to the patentability of independent claim 45, Applicants have not rewritten these claims in independent form.

Serial No. 09/872,500
Filed: 06/01/01
Page 8 of 8

Examiner: Thomas Price
Group Art Unit: 3643

In view of the foregoing remarks and amendments, it is submitted that all of the claims are in condition for allowance. Early notification of allowability is respectfully requested.

Respectfully submitted,

Matthew Dalesuk and Eugenie V. Uhlmann

Dated: 4.10.06

By: J. E. McGarry

John E. McGarry, Reg. No. 22,360
MCGARRY BAIR PC
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

G0221036